

REMARKS

Applicants address the examiner's remarks in the order presented in the Office Action (dated February 15, 2005). All claim amendments are made without prejudice and do not represent an acquiescence in any ground of rejection.

STATUS OF THE CLAIMS

Claims 53-65 are pending in the application. Claims 55 and 58-60 are cancelled without prejudice for pursuing in a continuation application. Claims 53 and 54 are amended. Claims 66-74 are new. With this Reply, claims 53, 54, 56, 57, and 61-74 will be pending. Support for new claims 66-74 can be found in the claims as previously presented.

Claim 53 was amended as suggested by the examiner. Applicants amended claim 53 for clarity and consistency of claim language. Claim 54 was amended to place the claim into proper form. No new matter is introduced by this amendment.

Claims 55 and 58 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The specification stands objected to because the title of the invention was not descriptive.

Claims 53, 54 and 59 stand objected to because of the following informalities: In claim 53, third to the last line, the examiner stated that "an object plane to be examined" should be --an object to be examined-- . In claim 54, "the table of the probe arm" lacks proper antecedent basis. In claim 59, "the plurality of diodes" lacks proper antecedent basis.

Claims 53, 54, 56, 57 and 61-65 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hignette *et al.* (U.S. Patent 5,191,393).

Claims 59 and 60 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hignette *et al.* in view of Hutley (U.S. Patent 4,600,831).

OBJECTIONS TO THE SPECIFICATION

The examiner objected to the specification. More specifically, the examiner was of the view that the title of the invention was not descriptive. The examiner required a new title that was more clearly indicative of the invention to which the claims are directed.

Applicants' representative has amended the title for clarity. Therefore the objection to the specification should be withdrawn.

OBJECTIONS TO THE CLAIMS

Claims 53, 54 and 59 were objected to because of various informalities. More specifically, in claim 53, third to the last line, the examiner stated that "an object plane to be examined" should be --an object to be examined-- . Applicants amended claim 53 as suggested by the examiner.

In claim 54, the examiner was of the opinion that the phrase "the table of the probe arm" lacks proper antecedent basis. Applicants amended claim 54 to reflect proper antecedent basis.

Claim 59 was cancelled to expedite prosecution, mooted the examiner's objection to this claim.

For at least these reasons, Applicants respectfully request reconsideration of the claims as amended. Applicants request the withdrawal of the objections to claims.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 53, 54, 56, 57 and 61-65 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hignette *et al.* (U.S. Patent 5,191,393).

Regarding claims 53, 54, 56, 57 and 61-65, the examiner stated that Hignette *et al.* disclose (see Figs. 1 and 2) a microscope, comprising: an imaging system (21) for creating an image of an object plane at 3) using an illumination light (from 22, 8) beam of a first wavelength comprising a plurality of lenses (not labeled) positioned along a main optical axis (at 29) of the microscope, and an optical output device (41, 42, 48) for creating an object plane image of the image plane; a system for automatically focusing (10, 33) the image in the microscope, comprising: an autofocusing light beam (see col. 6, lines 35-40 and FR2620537, incorporated by reference) of a second wavelength, the autofocusing light beam being directed to reflect off the object plane; an autofocusing detection device (see FR2620537) comprising a detection system lens for receiving the reflected autofocusing light beam and directing the reflected autofocusing light beam onto a detection surface; a plurality of light sensors (see FR2620537) adapted to measure the light intensity of the reflected autofocusing light beam as claimed; the imaging system further comprises: a probe arm (7) supporting the plurality of lenses, the probe arm extending generally along the main optical axis; a scanning stage and a support (4) on which an object to be examined is placed, wherein the object plane substantially extends along a focus plane that is observed through the microscope, and wherein the object plane is substantially parallel to the main optical axis. The examiner further stated that Hignette *et al.* also disclose (see Fig. 1) the scanning stage and the support are positioned on a separate table than a table of the probe arm (9), such that the probe arm is substantially isolated from vibrations created by the scanning stage.

Claims 55 and 58 were objected to as being dependent upon a rejected base claim (claim 53), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Therefore Applicants have amended claim 53 for greater clarity and consistency of claim language as suggested by the examiner.

Any claims depending from an independent claim include all of the independent claim limitations. Thus, if an independent claim is not found to be anticipated by a reference, then all of the claims which depend from that independent claim also cannot be anticipated by the same reference. Therefore, claims 54, 56, 57 and 61-65, which depend from claim 53, also cannot be anticipated by Hignette *et al.*

To the extent the 35 U.S.C. § 102(b) rejection applies to the new claims, Applicants' comments above regarding claim 53 and its dependent claims are also applicable to the new claims.

Without acceding to the propriety of the rejection of pending claims 53, 54, 56, 57 and 61-65 under 35 U.S.C. § 102(b), as allegedly being anticipated by Hignette *et al.* (U.S. Patent 5,191,393), Applicants respectfully request reconsideration of the claims as amended. For these reasons, Applicants request the examiner to withdraw the rejection of pending claims 53, 54, 56, 57 and 61-65 under 35 U.S.C. § 102(b).

REJECTIONS UNDER 35 U.S.C. § 103

Claims 59 and 60 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hignette *et al.*, in view of Hutley (U.S. Patent 4,600,831).

Regarding claims 59 and 60, Hignette *et al.* disclose the claimed invention as set forth above. Hignette *et al.* do not specifically disclose a cylindrical lens and a quad photo diode

as claimed. Hutley teaches (see Figs.) an autofocusing device having a cylindrical lens (32) and a quad photo diode (36). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide such elements in the apparatus of Hignette *et al.* in view of Hutley to increase sensitivity and improve focusing.

Without addressing the merits of the rejection and in order to expedite the prosecution of the application, Applicants cancelled claims 59 and 60, without prejudice or disclaimer, thereby rendering moot the rejection of claims 59 and 60 under 35 U.S.C. § 103(a). Accordingly, Applicants request withdrawal of the rejection.

ALLOWABLE SUBJECT MATTER

Claims 55 and 58 stand objected to as being dependent upon a rejected base claim (claim 53), but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants amended claim 53 as discussed above. Applicants have also added new claim 66 which incorporates the language of claim 53 and cancelled claim 58 so for at least these reasons, amended claim 53 and new claim 66 should be found allowable (and any of their respective dependent claims).

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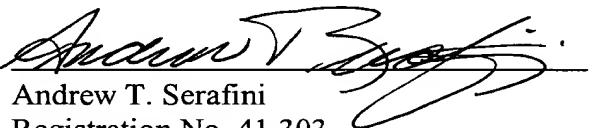
PATENT
REPLY FILED UNDER EXPEDITED
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37 CFR § 1.116

CONCLUSIONS

The foregoing represents a *bona fide* attempt to advance the present case to allowance. Applicants submit that this application is now in condition for allowance.

Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested. If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-332-1380.

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